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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,537	08/28/2000	Eric Mahr	Q59776	7787

7590 11/25/2003

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EXAMINER

JUNG, MIN

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 11/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,537

Applicant(s)

MAHR, ERIC

Examiner

Min Jung

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 6, 16, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 3, "the retrieved personalized message" lacks antecedent basis.

In claims 6, 16, 23, it is not clear what is meant by the limitation. According to the invention defined in the parent claims, the network is enabled for message origination messaging. That is, subscriber originates the messaging. With such feature as a core of the invention, it seems that the current limitation directly contradicts the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-24, 26-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lohtia et al., US 6,560,456 (Lohtia).

Lohtia discloses system and method for providing subscriber-initiated information over the short message service or a microbrowser.

Specifically, regarding claims 1, 9, 10, 14, 17, 19, 20, 26, 28, 29, and 31, Lohtia teaches a method of sending messages in a wireless communication network, comprising: transmitting from a subscriber's mobile station to a control center a predefined message initiation code (col. 6, lines 13-16), a message identifier identifying a predefined message (col. 6, lines 36-39) and an identifier of a receiving station (either the calling party number as in col. 53-56, or the receiving party number other than the originating handset as in col. 10, lines 22-28), wherein the predefined message is defined by or on behalf of the subscriber. See cols. 5-10. Further, Lohtia teaches a personalized message database storing messages predefined by or on behalf of a subscriber and in association with the subscriber and a message identifier (subscriber profile DB 311, col. 8, lines 40-45); and a call control center for retrieving the predefined

message and sending it to the receiving station (WWIS Gateway 302, col. 8, lines 46-66).

Regarding claims 2, 12, 15, and 21, in Lohtia, when the requesting wireless device is also the receiving device, the receiving of the requested information would read on the message delivery notification.

Regarding claim 3, Lohtia teaches retrieving the predefined message corresponding to the message identifier; and transmitting the retrieved predefined message to the receiving station. See col. 6, lines 36-52.

Regarding claims 4 and 24, Lohtia teaches that the identifier of the receiving station is a telephone number. See col. 6, lines 13-16.

Regarding claims 6, 16, and 23, no weight has been given to the limitation because the meaning of this limitation cannot be understood due to the indefiniteness.

Regarding claims 7, 22, 27, and 30, Lohtia teaches a wireless application protocol (WAP) enabled gateway, thereby inherently teaching a mobile station which can operate under the same protocol. See col. 8, lines 13-25.

Regarding claim 11, Lohtia teaches setting up the database with predefined messages prior to receiving the signal. See col. 8, lines 40-66.

Regarding claims 8, 13, 18, and 32, Lohtia teaches that the wireless network may be one of TIA IS 136, the GSM, CDMA, or any other standard or protocol which support SMS, microbrowser, or text messaging. See col. 4, lines 51-61.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 25, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lohtia.

Regarding claims 5 and 25, Lohtia fails to specifically teach the identifier of the receiving station being a distribution list identifier. However, it would be within a skilled person in the art to designate more than one recipient to receive the requested information. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to designate an identifier for a group list to distribute the same information to a group of recipients.

Regarding claim 33, Lohtia is silent on the formats used on the received information. Lohtia's teaching is in the field of providing information to a subscriber using a wireless handheld device. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to utilize the known formats adequate for such device including WML format, HDML format, and the CHTML format.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Meuronen et al. Patent, 6,292,669, the Havinis et al. patent,

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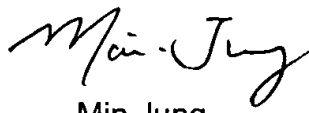
6,516,197, the Garcia patent, 6,633,764, and the Lee patent, 6,590,887 are cited for further references.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 703-305-4363. The examiner can normally be reached on Monday-Friday, 7AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

MJ
November 20, 2003


Min Jung
Primary Examiner